

In response to the Final Rejection, submitted herewith is a new declaration, entitled Third Substitute Declaration (Reissue), executed by Applicant. In addition, a Substitute Declaration of Thomas A. Boshinski in Support of Reissue is submitted.

Consideration of these declarations, and the following arguments, is respectfully requested notwithstanding the final rejection of the claims in this application. Applicant has been unable to find any provisions in the Rules of Patent Practice (37 C.F.R. Ch. 1) or in the Manual of Patent Examining Procedure relating to whether a reissue declaration may be submitted and considered following a Final rejection. However, in the event this situation is considered to be analogous to the presentation of amendments after final rejection, governed by 37 C.F.R. §1.116(b), consideration is requested in view of good and sufficient reasons why (1) the new declarations are necessary and (2) were not earlier presented.

The declaration of the applicant is a necessary part of an application to reissue a patent, and the two declarations overcome the rejection of the claims based upon a prior defective reissue declaration. As explained below, these new declarations satisfy the objections to the prior declarations raised by the Examiner.

The particular declarations submitted herewith were not earlier presented because they are directed to specific objections to the previously submitted declarations which were only raised by the Examiner for the first time in the Final office action. In particular, the Examiner in the Final office action states that applicant must treat each claim individually (i.e., point out the error sought to be corrected, how and when the error arose, how, when and by whom the error was discovered and a comparison of the claim with the closest claim in the original patent for each claim on a claim-by-claim basis), and not by blanket statements.<sup>1</sup> The Examiner further states that applicant must not compare the claims of the application to any claims of applicant's

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<sup>1</sup>The categorization of the various errors which appeared in Applicant's most recent prior response was in reply to the categorization of errors established in the preceding Office action.

'734 patent or the reexamination certificate for the '734 patent.<sup>2</sup> Finally, the Examiner has required applicant to identify the attorneys involved and meetings therewith that contributed to the discovery of the errors.

Applicant respectfully notes that in none of the four previous Office actions concerning the application (involving three different Examiners) were these specific objections brought to applicant's attention. Moreover, in response to each of the previous Office actions, applicant has submitted a declaration that addressed the various grounds of objection raised by the Examiners at that time. It is respectfully requested that since the particular objections now raised have only been raised after final rejection, applicant be given an opportunity to satisfy these objections through the presentation of the declarations submitted herewith.

As to the specific points raised by the Examiner in the Final Office action, it is noted that in the Third Substitute Declaration submitted herewith, applicant discusses each claim of the present application individually. Thus, for each claim, applicant has stated (1) what error the claim is seeking to correct; (2) how and when the error occurred; (3) how, when and by whom the error was discovered; and (4) how the claim compares with the closest claim of the original '947 patent.

(Each of the various errors in the specification has been similarly treated.)

Applicant has not stated, despite the Examiner's suggestion, how each error is correctable through reissue. It is believed that the legal basis for the correctability of each of the various

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<sup>2</sup>Applicant's comparison with the '734 patent presented in previous declarations was not based upon any intent on the part of applicant to correct errors in that proceeding. Rather, the discussion was presented in an attempt to aid the Examiner in understanding the scope and content of the claims presented for reissue in this proceeding. Any confusion which such discussion may have caused is regretted.

errors through reissue is more appropriately presented through attorney arguments. Such discussion is set forth in detail below.

In the Third Substitute Declaration, applicant has not made any comparison of claims to applicant's '734 patent or the reexamination certificate for the '734 patent.

Finally, the Third Substitute Declaration sets forth details regarding meetings with the "several attorneys" which contributed to the discovery of the errors in the '947 patent, as required by the Examiner.

#### Applicant's Third Substitute Declaration

The requirements of a reissue declaration are set forth in 37 C.F.R. §1.175(a). The specific elements are provided in subparagraphs (1), (2), (3), (5), (6) and (7), which require the applicant to make certain statements.

Subparagraph (1) requires that the Applicant,

When the applicant verily believes the original patent to be wholly or partly inoperative or invalid, [state] such belief and the reasons why.

In the Third Substitute Declaration, applicant states that he believes the '947 patent to be partly inoperative by reason of a defective specification, Third Substitute Declaration at paragraph 618 (hereinafter cited as "*TSD at 618*"), and by reason of the patentee claiming less than he had the right to claim in the patent, *TSD at 6*.

Subparagraph (2) requires that the Applicant,

When it is claimed that such patent is so inoperative or invalid "by reason of a defective specification or drawing," particularly [specify] such defects.

In the Third Substitute Declaration, applicant specifies in detail, with reference to column and line number, the defects in the specification of the '947 patent. See *TSD at 619-655*.

Subparagraph (3) requires that the Applicant,

When it is claimed that such patent is inoperative or invalid "by reason of the patentee claiming more or less than he had a right to claim in the patent," distinctly [specify] the excess or insufficiency in the claims.

In the Third Substitute Declaration, applicant discusses in specific detail each claim added to the '947 patent in the reissue application. This satisfies the Examiner's requirement that applicant state "what error [the claim] is seeking to correct," and how the claim compares with "the closest claim in the original patent." See *TSD at 7-617*.

Subparagraph (5) requires that the Applicant

Particularly [specify] the errors relied upon, and how they arose or occurred.

In the Third Substitute Declaration, applicant discusses in detail each claim added in the reissue, and each correction to the specification. As part of such discussion, and as required by the Examiner, applicant states "how and when the error occurred." See *TSD at 7-617*.

Subparagraph (6) requires that the Applicant

[State] that said errors arose "without any deceptive intention" on the part of the applicant.

In the Third Substitute Declaration, applicant states that the errors "arose 'without any deceptive intention' on the part of the applicant." *TSD at 5*. As part of the detailed discussion of each claim added in the reissue and each defect in the specification, applicant states "how, when and by whom the error was discovered." See generally *TSD at 7-617*.

Subparagraph (7) requires that the Applicant

[Acknowledge] the duty to disclose to the Office all information known to applicants to be material to patentability as defined in §1.56.

At *TSD at 4*, applicant makes the required acknowledgment.

The Substitute Declaration of Thomas A. Boshinski in Support of Reissue provides corroboration for statements made in applicant's declaration.

Each of the errors resulting in added claims, and each of the errors in the specification, are now discussed in detail, including the reasons why such errors are correctable through reissue.<sup>3</sup>

### Errors in the Claims

#### *Claim 5*

Claim 5 corrects applicant's failure to claim in the '947 patent any method of controlling a television receiver. This error arose through applicant and his attorney inadvertently failing to appreciate that a method claim in accord with claim 5 was within the scope of the invention, and that such a claim should have been presented in the application for the '947 patent.

This error is properly correctable through reissue. "An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents." *In re Wilder*, 222 USPQ 369, 371 (CAFC 1984). Such error supports a broadening reissue application. "[A] broadened reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention." *In re Amos*, 21 USPQ2d 1271, 1273 (CAFC 1991).

The error may result from the failure to present claims of a different category, as in the case of method claim 5 of this application. See, e.g., *Scripps Clinic v. Genentech, Inc.*, 18 USPQ2d 1001, 1008-09 (CAFC 1991), where the error was the failure to include product claims in a patent containing only process and product-by-process claims.

Moreover, whether the errors could have been avoided is immaterial. As stated by the CAFC in *Scripps Clinic*, 18 USPQ2d at 1009, "[t]he law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue."

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<sup>3</sup>To make the discussion of *each* claim as complete as possible, much of the discussion of the various claims set forth herein is, unfortunately, quite repetitive.

The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 7-15.*

*Claim 7*

Claim 7 corrects applicant's failure to claim in the '947 patent a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element, and specifically in a claim which included the elements recited in claim 7. This error arose through applicant and his attorney failing to appreciate that it was not necessary to include the tuner means of the television receiver as an element in claims to the control apparatus which applicant had invented, and that a claim in accord with claim 7 was within the scope of the invention, and that it should have been presented in the application for the '947 patent.

This error is properly correctable through reissue. "An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents." *In re Wilder*, 222 USPQ 369, 371 (CAFC 1984). Such error supports a broadening reissue application. "[A] broadened reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention." *In re Amos*, 21 USPQ2d 1271, 1273 (CAFC 1991).

Moreover, whether the errors could have been avoided is immaterial. As stated by the CAFC in *Scripps Clinic*, 18 USPQ2d at 1009, "[t]he law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue."

The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 16-24.*

*Claim 8*

Claim 8 corrects applicant's failure to claim in the '947 patent a control apparatus for a television receiver in which the apparatus could store channel designations in an ordered cue as determined by the operator, and specifically in a claim which included the elements recited in

claim 8. This error arose through applicant and his attorney failing to appreciate that the invention included within its scope an apparatus which could store channel designations in an ordered cue as determined by the operator, without incorporation into a remote control device in combination with the operator-selected channel designation feature. Applicant and his attorney failed to appreciate that a claim in accord with claim 8 was within the scope of the invention, and that it should have been presented in the application for the '947 patent.

This error is properly correctable through reissue. "An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents." *In re Wilder*, 222 USPQ 369, 371 (CAFC 1984). Such error supports a broadening reissue application. "[A] broadened reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention." *In re Amos*, 21 USPQ2d 1271, 1273 (CAFC 1991).

Moreover, whether the errors could have been avoided is immaterial. As stated by the CAFC in *Scripps Clinic*, 18 USPQ2d at 1009, "[t]he law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue."

The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 25-33*.

#### *Claim 9*

Claim 9 corrects applicant's failure to claim in the '947 patent a control apparatus for a television receiver in which the apparatus could store channel designations in a plurality of ordered cues, and specifically in a claim which included the elements recited in claim 9. This error arose through applicant and his attorney failing to appreciate that the invention included within its scope an apparatus which could store channel designations in a plurality of ordered cues, without incorporation into a remote control device in combination with the operator-selected channel designation feature. Applicant and his attorney failed to appreciate that a claim

in accord with claim 9 was within the scope of the invention, and that it should have been presented in the application for the '947 patent.

This error is properly correctable through reissue. "An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents." *In re Wilder*, 222 USPQ 369, 371 (CAFC 1984). Such error supports a broadening reissue application. "[A] broadened reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention." *In re Amos*, 21 USPQ2d 1271, 1273 (CAFC 1991).

Moreover, whether the errors could have been avoided is immaterial. As stated by the CAFC in *Scripps Clinic*, 18 USPQ2d at 1009, "[t]he law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue."

The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 34-42*.

#### *Claim 10*

Claim 10 corrects applicant's failure to claim in the '947 patent a control apparatus for a television receiver in which the apparatus could store channel designations in a plurality of ordered cues, and which includes means for generating a cue selection signal, and specifically in a claim which included the elements recited in claim 10. This error arose through applicant and his attorney failing to appreciate that the invention included within its scope an apparatus which could store channel designations in a plurality of ordered cues, and which includes means for generating a cue selection signal, without incorporation into a remote control device in combination with the operator-selected channel designation feature. Applicant and his attorney failed to appreciate that a claim in accord with claim 10 was within the scope of the invention, and that it should have been presented in the application for the '947 patent.



This error is properly correctable through reissue.<sup>4</sup> "An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents." *In re Wilder*, 222 USPQ 369, 371 (CAFC 1984). Such error supports a broadening reissue application. "[A] broadened reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention." *In re Amos*, 21 USPQ2d 1271, 1273 (CAFC 1991).

Moreover, whether the errors could have been avoided is immaterial. As stated by the CAFC in *Scripps Clinic*, 18 USPQ2d at 1009, "[t]he law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue."

The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 43-50*.

#### *Claim 11*

Claim 11 corrects applicant's failure to claim in the '947 patent a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element, and specifically in a claim which included the elements recited in claim 11. This error arose through applicant and his attorney failing to appreciate that it was not necessary to include the tuner means of the television receiver as an element in claims to the control apparatus which applicant had invented, and that a claim in accord with claim 11 was within the scope of the invention, and that it should have been presented in the application for the '947 patent.

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<sup>4</sup>In the previous Office Action dated March 31, 1997, the Examiner suggested that certain claims of the application, which would include claim 10, actually provided "narrower" protection than in the original patent, and was inconsistent with applicant's broadening reissue application. Applicant's Response filed April 30, 1997 discussed in connection with "Errors F2 and F3" that the presentation of *additional* claims was proper in a broadening reissue. See *Hewlett-Packard v. Bausch & Lomb*, 11 USPQ2d 1750, 1757 (CAFC 1989), citing *In re Handel*, 136 USPQ 460, 462 n.2 (CCPA 1963).

However, after further consideration, applicant now recognizes that claim 10 (as well as other "narrower" claims) cover subject matter *that was not covered* by the original '947 patent, and thus represents a broadening of the scope of the '947 patent in the more common sense.

This error is properly correctable through reissue. "An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents." *In re Wilder*, 222 USPQ 369, 371 (CAFC 1984). Such error supports a broadening reissue application. "[A] broadened reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention." *In re Amos*, 21 USPQ2d 1271, 1273 (CAFC 1991).

Moreover, whether the errors could have been avoided is immaterial. As stated by the CAFC in *Scripps Clinic*, 18 USPQ2d at 1009, "[t]he law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue."

The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 51-60*.

#### *Claim 12*

Claim 12 corrects applicant's failure to claim in the '947 patent a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element, and specifically in a claim which included the elements recited in claim 12. This error arose through applicant and his attorney failing to appreciate that it was not necessary to include the tuner means of the television receiver as an element in claims to the control apparatus which applicant had invented, and that a claim in accord with claim 12 was within the scope of the invention, and that it should have been presented in the application for the '947 patent.

This error is properly correctable through reissue. "An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents." *In re Wilder*, 222 USPQ 369, 371 (CAFC 1984). Such error supports a broadening reissue application. "[A] broadened reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention." *In re Amos*, 21 USPQ2d 1271, 1273 (CAFC 1991).

Moreover, whether the errors could have been avoided is immaterial. As stated by the CAFC in *Scripps Clinic*, 18 USPQ2d at 1009, "[t]he law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue."

The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 61-70.*

### *Claim 13*

Claim 13 corrects applicant's failure to claim in the '947 patent a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element, and specifically in a claim which included the elements recited in claim 13. This error arose through applicant and his attorney failing to appreciate that it was not necessary to include the tuner means of the television receiver as an element in claims to the control apparatus which applicant had invented, and that a claim in accord with claim 13 was within the scope of the invention, and that it should have been presented in the application for the '947 patent.

This error is properly correctable through reissue. "An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents." *In re Wilder*, 222 USPQ 369, 371 (CAFC 1984). Such error supports a broadening reissue application. "[A] broadened reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention." *In re Amos*, 21 USPQ2d 1271, 1273 (CAFC 1991).

Moreover, whether the errors could have been avoided is immaterial. As stated by the CAFC in *Scripps Clinic*, 18 USPQ2d at 1009, "[t]he law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue."

The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 71-80.*

*Claim 14*

Claim 14 corrects applicant's failure to claim in the '947 patent a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element, and specifically in a claim which included the elements recited in claim 14. This error arose through applicant and his attorney failing to appreciate that it was not necessary to include the tuner means of the television receiver as an element in claims to the control apparatus which applicant had invented, and that a claim in accord with claim 14 was within the scope of the invention, and that it should have been presented in the application for the '947 patent.

This error is properly correctable through reissue. "An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents." *In re Wilder*, 222 USPQ 369, 371 (CAFC 1984). Such error supports a broadening reissue application. "[A] broadened reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention." *In re Amos*, 21 USPQ2d 1271, 1273 (CAFC 1991).

Moreover, whether the errors could have been avoided is immaterial. As stated by the CAFC in *Scripps Clinic*, 18 USPQ2d at 1009, "[t]he law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue."

The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 81-90*.

*Claim 15*

Claim 15 corrects applicant's failure to claim in the '947 patent a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element, and specifically in a claim which included the elements recited in claim 15. This error arose through applicant and his attorney failing to appreciate that it was not necessary to include the tuner means of the television receiver as an element in claims to the control apparatus which

applicant had invented, and that a claim in accord with claim 15 was within the scope of the invention, and that it should have been presented in the application for the '947 patent.

This error is properly correctable through reissue. "An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents." *In re Wilder*, 222 USPQ 369, 371 (CAFC 1984). Such error supports a broadening reissue application. "[A] broadened reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention." *In re Amos*, 21 USPQ2d 1271, 1273 (CAFC 1991).

Moreover, whether the errors could have been avoided is immaterial. As stated by the CAFC in *Scripps Clinic*, 18 USPQ2d at 1009, "[t]he law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue."

The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 91-100*.

#### *Claim 16*

Claim 16 corrects applicant's failure to claim in the '947 patent a control apparatus for a television receiver in which the apparatus could store channel designations in an ordered cue as determined by the operator, and specifically in a claim which included the elements recited in claim 16. This error arose through applicant and his attorney failing to appreciate that the invention included within its scope an apparatus which could store channel designations in an ordered cue as determined by the operator, without incorporation into a remote control device in combination with the operator-selected channel designation feature. Applicant and his attorney failed to appreciate that a claim in accord with claim 16 was within the scope of the invention, and that it should have been presented in the application for the '947 patent.

This error is properly correctable through reissue. "An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents." *In re Wilder*,

222 USPQ 369, 371 (CAFC 1984). Such error supports a broadening reissue application. "[A] broadened reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention." *In re Amos*, 21 USPQ2d 1271, 1273 (CAFC 1991).

Moreover, whether the errors could have been avoided is immaterial. As stated by the CAFC in *Scripps Clinic*, 18 USPQ2d at 1009, "[t]he law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue."

The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 101-110*.

#### *Claim 17*

Claim 17 corrects applicant's failure to claim in the '947 patent a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element, in which the processor performed operations "in response to" the presence of a particular signal, and specifically in a claim which included the elements recited in claim 17. This error arose through applicant and his attorney failing to appreciate that it was not necessary to include the tuner means of the television receiver as an element in claims to the control apparatus which applicant had invented, and that a claim in accord with claim 17 was within the scope of the invention, and that it should have been presented in the application for the '947 patent.

This error is properly correctable through reissue. "An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents." *In re Wilder*, 222 USPQ 369, 371 (CAFC 1984). Such error supports a broadening reissue application. "[A] broadened reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention." *In re Amos*, 21 USPQ2d 1271, 1273 (CAFC 1991).

Moreover, whether the errors could have been avoided is immaterial. As stated by the CAFC in *Scripps Clinic*, 18 USPQ2d at 1009, "[t]he law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue."

The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 111-122.*

### *Claim 18*

Claim 18 corrects applicant's failure to claim in the '947 patent a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element, in which the processor performed operations "in response to" the presence of a particular signal, and specifically in a claim which included the elements recited in claim 18. This error arose through applicant and his attorney failing to appreciate that it was not necessary to include the tuner means of the television receiver as an element in claims to the control apparatus which applicant had invented, and that a claim in accord with claim 18 was within the scope of the invention, and that it should have been presented in the application for the '947 patent.

This error is properly correctable through reissue. "An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents." *In re Wilder*, 222 USPQ 369, 371 (CAFC 1984). Such error supports a broadening reissue application. "[A] broadened reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention." *In re Amos*, 21 USPQ2d 1271, 1273 (CAFC 1991).

Moreover, whether the errors could have been avoided is immaterial. As stated by the CAFC in *Scripps Clinic*, 18 USPQ2d at 1009, "[t]he law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue."

The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 123-132.*

*Claim 19*

Claim 18 corrects applicant's failure to claim in the '947 patent a control apparatus for a television receiver in which the apparatus receives a multi-channel input including a plurality of active channels, and in which the memory stores a channel select designation for each of the active channels which is identical thereto, and specifically in a claim which included the elements recited in claim 19. This error arose through applicant and his attorney failing to appreciate that it was not necessary to include the tuner means of the television receiver as an element in claims to the control apparatus which applicant had invented, and that a claim in accord with claim 19 was within the scope of the invention, and that it should have been presented in the application for the '947 patent.

This error is properly correctable through reissue. "An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents." *In re Wilder*, 222 USPQ 369, 371 (CAFC 1984). Such error supports a broadening reissue application. "[A] broadened reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention." *In re Amos*, 21 USPQ2d 1271, 1273 (CAFC 1991).

Moreover, whether the errors could have been avoided is immaterial. As stated by the CAFC in *Scripps Clinic*, 18 USPQ2d at 1009, "[t]he law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue."

The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 133-142*.

*Claim 21*

Claim 21 corrects applicant's failure to claim in the '947 patent a control apparatus for a television receiver in which the apparatus could store channel designations in an ordered cue as determined by the operator, in which the processor performed operations "in response to" the presence of a particular signal, and specifically in a claim which included the elements recited



in claim 21. This error arose through applicant and his attorney failing to appreciate that the invention included within its scope an apparatus which could store channel designations in an ordered cue as determined by the operator, without incorporation into a remote control device in combination with the operator-selected channel designation feature. Applicant and his attorney failed to appreciate that a claim in accord with claim 21 was within the scope of the invention, and that it should have been presented in the application for the '947 patent.

This error is properly correctable through reissue. "An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents." *In re Wilder*, 222 USPQ 369, 371 (CAFC 1984). Such error supports a broadening reissue application. "[A] broadened reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention." *In re Amos*, 21 USPQ2d 1271, 1273 (CAFC 1991).

Moreover, whether the errors could have been avoided is immaterial. As stated by the CAFC in *Scripps Clinic*, 18 USPQ2d at 1009, "[t]he law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue."

The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 143-155*.

#### *Claim 22*

Claim 22 corrects applicant's failure to claim in the '947 patent a control apparatus for a television receiver in which the apparatus could store channel designations in an ordered cue, in which the processor performed operations "in response to" the presence of a particular signal, and specifically in a claim which included the elements recited in claim 22. This error arose through applicant and his attorney failing to appreciate that the invention included within its scope an apparatus which could store channel designations in an ordered cue, without incorporation into a remote control device in combination with the operator-selected channel designation feature. Applicant and his attorney failed to appreciate that a claim in accord with

claim 22 was within the scope of the invention, and that it should have been presented in the application for the '947 patent.

This error is properly correctable through reissue. "An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents." *In re Wilder*, 222 USPQ 369, 371 (CAFC 1984). Such error supports a broadening reissue application. "[A] broadened reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention." *In re Amos*, 21 USPQ2d 1271, 1273 (CAFC 1991).

Moreover, whether the errors could have been avoided is immaterial. As stated by the CAFC in *Scripps Clinic*, 18 USPQ2d at 1009, "[t]he law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue."

The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 156-168*.

### *Claim 23*

Claim 23 corrects applicant's failure to claim in the '947 patent a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element, in which the processor performed operations "in response to" the presence of a particular signal, and specifically in a claim which included the elements recited in claim 23. This error arose through applicant and his attorney failing to appreciate that it was not necessary to include the tuner means of the television receiver as an element in claims to the control apparatus which applicant had invented, and that a claim in accord with claim 23 was within the scope of the invention, and that it should have been presented in the application for the '947 patent.

This error is properly correctable through reissue. "An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents." *In re Wilder*, 222 USPQ 369, 371 (CAFC 1984). Such error supports a broadening reissue application. "[A]

broadened reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention." *In re Amos*, 21 USPQ2d 1271, 1273 (CAFC 1991).

Moreover, whether the errors could have been avoided is immaterial. As stated by the CAFC in *Scripps Clinic*, 18 USPQ2d at 1009, "[t]he law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue."

The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 169-181*.

#### *Claim 24*

Claim 24 corrects applicant's failure to claim in the '947 patent a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element, in which the processor performed operations "in response to" the presence of a particular signal, and specifically in a claim which included the elements recited in claim 24. This error arose through applicant and his attorney failing to appreciate that it was not necessary to include the tuner means of the television receiver as an element in claims to the control apparatus which applicant had invented, and that a claim in accord with claim 24 was within the scope of the invention, and that it should have been presented in the application for the '947 patent.

This error is properly correctable through reissue. "An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents." *In re Wilder*, 222 USPQ 369, 371 (CAFC 1984). Such error supports a broadening reissue application. "[A] broadened reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention." *In re Amos*, 21 USPQ2d 1271, 1273 (CAFC 1991).

Moreover, whether the errors could have been avoided is immaterial. As stated by the CAFC in *Scripps Clinic*, 18 USPQ2d at 1009, "[t]he law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue."

The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 182-195.*

*Claim 25*

Claim 25 corrects applicant's failure to claim in the '947 patent a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element, in which the processor performed operations "in response to" the presence of a particular signal, and specifically in a claim which included the elements recited in claim 25. This error arose through applicant and his attorney failing to appreciate that it was not necessary to include the tuner means of the television receiver as an element in claims to the control apparatus which applicant had invented, and that a claim in accord with claim 25 was within the scope of the invention, and that it should have been presented in the application for the '947 patent.

This error is properly correctable through reissue. "An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents." *In re Wilder*, 222 USPQ 369, 371 (CAFC 1984). Such error supports a broadening reissue application. "[A] broadened reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention." *In re Amos*, 21 USPQ2d 1271, 1273 (CAFC 1991).

Moreover, whether the errors could have been avoided is immaterial. As stated by the CAFC in *Scripps Clinic*, 18 USPQ2d at 1009, "[t]he law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue."

The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 196-209.*

*Claim 26*

Claim 26 corrects applicant's failure to claim in the '947 patent a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element,

in which the processor performed operations "in response to" the presence of a particular signal, and specifically in a claim which included the elements recited in claim 26. This error arose through applicant and his attorney failing to appreciate that it was not necessary to include the tuner means of the television receiver as an element in claims to the control apparatus which applicant had invented, and that a claim in accord with claim 26 was within the scope of the invention, and that it should have been presented in the application for the '947 patent.

This error is properly correctable through reissue. "An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents." *In re Wilder*, 222 USPQ 369, 371 (CAFC 1984). Such error supports a broadening reissue application. "[A] broadened reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention." *In re Amos*, 21 USPQ2d 1271, 1273 (CAFC 1991).

Moreover, whether the errors could have been avoided is immaterial. As stated by the CAFC in *Scripps Clinic*, 18 USPQ2d at 1009, "[t]he law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue."

The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 210-223*.

#### *Claim 27*

Claim 27 corrects applicant's failure to claim in the '947 patent a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element, in which the processor performed operations "in response to" the presence of a particular signal, and specifically in a claim which included the elements recited in claim 27. This error arose through applicant and his attorney failing to appreciate that it was not necessary to include the tuner means of the television receiver as an element in claims to the control apparatus which applicant had invented, and that a claim in accord with claim 27 was within the scope of the invention, and that it should have been presented in the application for the '947 patent.

This error is properly correctable through reissue. "An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents." *In re Wilder*, 222 USPQ 369, 371 (CAFC 1984). Such error supports a broadening reissue application. "[A] broadened reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention." *In re Amos*, 21 USPQ2d 1271, 1273 (CAFC 1991).

Moreover, whether the errors could have been avoided is immaterial. As stated by the CAFC in *Scripps Clinic*, 18 USPQ2d at 1009, "[t]he law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue."

The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 224-237*.

#### *Claim 28*

Claim 28 corrects applicant's failure to claim in the '947 patent a control apparatus for a television receiver in which the apparatus could store channel designations in an ordered cue, in which the processor performed operations "in response to" the presence of a particular signal, and specifically in a claim which included the elements recited in claim 28. This error arose through applicant and his attorney failing to appreciate that the invention included within its scope an apparatus which could store channel designations in an ordered cue, without incorporation into a remote control device in combination with the operator-selected channel designation feature. Applicant and his attorney failed to appreciate that a claim in accord with claim 28 was within the scope of the invention, and that it should have been presented in the application for the '947 patent.

This error is properly correctable through reissue. "An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents." *In re Wilder*, 222 USPQ 369, 371 (CAFC 1984). Such error supports a broadening reissue application. "[A]

broadened reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention." *In re Amos*, 21 USPQ2d 1271, 1273 (CAFC 1991).

Moreover, whether the errors could have been avoided is immaterial. As stated by the CAFC in *Scripps Clinic*, 18 USPQ2d at 1009, "[t]he law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue."

The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 238-251*.

#### *Claim 30*

Claim 30 corrects applicant's failure to claim in the '947 patent a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element. Claim 30 also corrects applicant's failure to claim in the '947 patent a control apparatus which included as elements "a memory," "an operator-actuated control device," and "a processor," specifically in a claim which included the elements recited in claim 30. This error arose through applicant and his attorney failing to appreciate that it was not necessary to include the tuner means of the television receiver as an element in claims to the control apparatus which applicant had invented, and that the recited claim elements could have been presented in a form other than as a "means" for performing a function. Applicant and his attorney failed to appreciate that a claim in accord with claim 30 was within the scope of the invention, and that it should have been presented in the application for the '947 patent.

This error is properly correctable through reissue. "An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents." *In re Wilder*, 222 USPQ 369, 371 (CAFC 1984). Such error supports a broadening reissue application. "[A] broadened reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention." *In re Amos*, 21 USPQ2d 1271, 1273 (CAFC 1991).

Moreover, whether the errors could have been avoided is immaterial. As stated by the CAFC in *Scripps Clinic*, 18 USPQ2d at 1009, "[t]he law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue."

One particular error which is corrected by claim 30 pertains to the inclusion in all of the claims of the '947 patent of claim elements expressed in terms of "means for" language. By not including some claims which did not use the expression "means for," applicant erroneously failed to claim the invention sufficiently broadly. (See further discussion, *infra*.)

As explained in the attorney's declaration, Substitute Declaration of Thomas A. Boshinski at paragraph 153 (hereinafter cited as "*Sub. Boshinski Decl. at 153*"), this error was discovered during 1994 as a result of the CAFC decision in *In re Donaldson*, 29 USPQ2d 1845 (1994). In its decision, the CAFC required that the PTO apply the "equivalents" analysis mandated by 35 USC 112, sixth paragraph, to its consideration of claims for patentability under sections 102 and 103. As a result of that decision, and subsequent discussions with applicant's trial counsel and other professional colleagues, applicant's attorney realized that the claims of the '947 patent should have included claims in which the elements were not expressed as "means" for performing various functions.

The fact that this error could perhaps be characterized as "legal" error, rather than factual error, does not preclude this error from being correctable by reissue. As noted by the CAFC in *Scripps Clinic v. Genentech Inc.*, *supra*, 18 USPQ2d at 1009, "[a]n error of law is not excluded from the class of error subject to correction in accordance with the reissue statute." Thus, this particular is a proper error for correction by reissue.

The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 252-265*.



*Claim 31*

Claim 31 corrects applicant's failure to claim in the '947 patent a control apparatus for a television receiver in which the apparatus could store channel designations in an ordered cue. Claim 31 also corrects applicant's failure to claim in the '947 patent a control apparatus which included as elements "a tuner," "a memory," "an operator-actuated control device," and "a processor," specifically in a claim which included the elements recited in claim 31. This error arose through applicant and his attorney failing to appreciate that the invention included within its scope an apparatus which could store channel designations in an ordered cue, without incorporation into a remote control device in combination with the operator-selected channel designation feature, and that the recited claim elements could have been presented in a form other than as a "means" for performing a function. Applicant and his attorney failed to appreciate that a claim in accord with claim 31 was within the scope of the invention, and that it should have been presented in the application for the '947 patent.

This error is properly correctable through reissue. "An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents." *In re Wilder*, 222 USPQ 369, 371 (CAFC 1984). Such error supports a broadening reissue application. "[A] broadened reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention." *In re Amos*, 21 USPQ2d 1271, 1273 (CAFC 1991).

Moreover, whether the errors could have been avoided is immaterial. As stated by the CAFC in *Scripps Clinic*, 18 USPQ2d at 1009, "[t]he law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue."

One particular error which is corrected by claim 31 pertains to the inclusion in all of the claims of the '947 patent of claim elements expressed in terms of "means for" language. By not including some claims which did not use the expression "means for," applicant erroneously failed to claim the invention sufficiently broadly. (See further discussion, *infra*.)

As explained in the attorney's declaration, *Sub. Boshinski Decl. at 161*, this error was discovered during 1994 as a result of the CAFC decision in *In re Donaldson*, 29 USPQ2d 1845 (1994). In its decision, the CAFC required that the PTO apply the "equivalents" analysis mandated by 35 USC 112, sixth paragraph, to its consideration of claims for patentability under sections 102 and 103. As a result of that decision, and subsequent discussions with applicant's trial counsel and other professional colleagues, applicant's attorney realized that the claims of the '947 patent should have included claims in which the elements were not expressed as "means" for performing various functions.

The fact that this error could perhaps be characterized as "legal" error, rather than factual error, does not preclude this error from being correctable by reissue. As noted by the CAFC in *Scripps Clinic v. Genentech Inc.*, *supra*, 18 USPQ2d at 1009, "[a]n error of law is not excluded from the class of error subject to correction in accordance with the reissue statute." Thus, this particular is a proper error for correction by reissue.

The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 266-279*.

#### *Claim 32*

Claim 32 corrects applicant's failure to claim in the '947 patent a control apparatus for a television receiver in which the apparatus could store channel designations in an ordered cue. Claim 31 also corrects applicant's failure to claim in the '947 patent a control apparatus which included as elements "a tuner," "a memory," "an operator-actuated control device," and "a processor," specifically in a claim which included the elements recited in claim 32. This error arose through applicant and his attorney failing to appreciate that the invention included within its scope an apparatus which could store channel designations in an ordered cue, without incorporation into a remote control device in combination with the operator-selected channel designation feature, and that the recited claim elements could have been presented in a form other than as a "means" for performing a function. Applicant and his attorney failed to

appreciate that a claim in accord with claim 32 was within the scope of the invention, and that it should have been presented in the application for the '947 patent.

This error is properly correctable through reissue. "An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents." *In re Wilder*, 222 USPQ 369, 371 (CAFC 1984). Such error supports a broadening reissue application. "[A] broadened reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention." *In re Amos*, 21 USPQ2d 1271, 1273 (CAFC 1991).

Moreover, whether the errors could have been avoided is immaterial. As stated by the CAFC in *Scripps Clinic*, 18 USPQ2d at 1009, "[t]he law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue."

One particular error which is corrected by claim 32 pertains to the inclusion in all of the claims of the '947 patent of claim elements expressed in terms of "means for" language. By not including some claims which did not use the expression "means for," applicant erroneously failed to claim the invention sufficiently broadly. (See further discussion, *infra*.)

As explained in the attorney's declaration, *Sub. Boshinski Decl. at 169*, this error was discovered during 1994 as a result of the CAFC decision in *In re Donaldson*, 29 USPQ2d 1845 (1994). In its decision, the CAFC required that the PTO apply the "equivalents" analysis mandated by 35 USC 112, sixth paragraph, to its consideration of claims for patentability under sections 102 and 103. As a result of that decision, and subsequent discussions with applicant's trial counsel and other professional colleagues, applicant's attorney realized that the claims of the '947 patent should have included claims in which the elements were not expressed as "means" for performing various functions.

The fact that this error could perhaps be characterized as "legal" error, rather than factual error, does not preclude this error from being correctable by reissue. As noted by the CAFC in

*Scripps Clinic v. Genentech Inc., supra*, 18 USPQ2d at 1009, "[a]n error of law is not excluded from the class of error subject to correction in accordance with the reissue statute." Thus, this particular is a proper error for correction by reissue.

The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 280-293*.

### *Claim 33*

Claim 33 corrects applicant's failure to claim in the '947 patent a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element. Claim 33 also corrects applicant's failure to claim in the '947 patent a control apparatus which included as elements "a tuner," "a memory," "an operator-actuated control device," and "a processor," specifically in a claim which included the elements recited in claim 33. This error arose through applicant and his attorney failing to appreciate that it was not necessary to include the tuner means of the television receiver as an element in claims to the control apparatus which applicant had invented, and that the recited claim elements could have been presented in a form other than as a "means" for performing a function. Applicant and his attorney failed to appreciate that a claim in accord with claim 33 was within the scope of the invention, and that it should have been presented in the application for the '947 patent.

This error is properly correctable through reissue. "An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents." *In re Wilder*, 222 USPQ 369, 371 (CAFC 1984). Such error supports a broadening reissue application. "[A] broadened reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention." *In re Amos*, 21 USPQ2d 1271, 1273 (CAFC 1991).

Moreover, whether the errors could have been avoided is immaterial. As stated by the CAFC in *Scripps Clinic*, 18 USPQ2d at 1009, "[t]he law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue."

One particular error which is corrected by claim 33 pertains to the inclusion in all of the claims of the '947 patent of claim elements expressed in terms of "means for" language. By not including some claims which did not use the expression "means for," applicant erroneously failed to claim the invention sufficiently broadly. (See further discussion, *infra*.)

As explained in the attorney's declaration, *Sub. Boshinski Decl. at 177*, this error was discovered during 1994 as a result of the CAFC decision in *In re Donaldson*, 29 USPQ2d 1845 (1994). In its decision, the CAFC required that the PTO apply the "equivalents" analysis mandated by 35 USC 112, sixth paragraph, to its consideration of claims for patentability under sections 102 and 103. As a result of that decision, and subsequent discussions with applicant's trial counsel and other professional colleagues, applicant's attorney realized that the claims of the '947 patent should have included claims in which the elements were not expressed as "means" for performing various functions.

The fact that this error could perhaps be characterized as "legal" error, rather than factual error, does not preclude this error from being correctable by reissue. As noted by the CAFC in *Scripps Clinic v. Genentech Inc.*, *supra*, 18 USPQ2d at 1009, "[a]n error of law is not excluded from the class of error subject to correction in accordance with the reissue statute." Thus, this particular is a proper error for correction by reissue.

The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 294-307*.

#### *Claim 34*

Claim 34 corrects applicant's failure to claim in the '947 patent a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element. Claim 34 also corrects applicant's failure to claim in the '947 patent a control apparatus which included as elements "a tuner," "a memory," "an operator-actuated control device," and "a processor," specifically in a claim which included the elements recited in claim 34. This error

arose through applicant and his attorney failing to appreciate that it was not necessary to include the tuner means of the television receiver as an element in claims to the control apparatus which applicant had invented, and that the recited claim elements could have been presented in a form other than as a "means" for performing a function. Applicant and his attorney failed to appreciate that a claim in accord with claim 34 was within the scope of the invention, and that it should have been presented in the application for the '947 patent.

This error is properly correctable through reissue. "An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents." *In re Wilder*, 222 USPQ 369, 371 (CAFC 1984). Such error supports a broadening reissue application. "[A] broadened reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention." *In re Amos*, 21 USPQ2d 1271, 1273 (CAFC 1991).

Moreover, whether the errors could have been avoided is immaterial. As stated by the CAFC in *Scripps Clinic*, 18 USPQ2d at 1009, "[t]he law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue."

One particular error which is corrected by claim 34 pertains to the inclusion in all of the claims of the '947 patent of claim elements expressed in terms of "means for" language. By not including some claims which did not use the expression "means for," applicant erroneously failed to claim the invention sufficiently broadly. (See further discussion, *infra*.)

As explained in the attorney's declaration, *Sub. Boshinski Decl. at 185*, this error was discovered during 1994 as a result of the CAFC decision in *In re Donaldson*, 29 USPQ2d 1845 (1994). In its decision, the CAFC required that the PTO apply the "equivalents" analysis mandated by 35 USC 112, sixth paragraph, to its consideration of claims for patentability under sections 102 and 103. As a result of that decision, and subsequent discussions with applicant's trial counsel and other professional colleagues, applicant's attorney realized that the claims of

the '947 patent should have included claims in which the elements were not expressed as "means" for performing various functions.

The fact that this error could perhaps be characterized as "legal" error, rather than factual error, does not preclude this error from being correctable by reissue. As noted by the CAFC in *Scripps Clinic v. Genentech Inc.*, *supra*, 18 USPQ2d at 1009, "[a]n error of law is not excluded from the class of error subject to correction in accordance with the reissue statute." Thus, this particular is a proper error for correction by reissue.

The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 308-321.*

#### *Claim 35*

Claim 35 corrects applicant's failure to claim in the '947 patent a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element. Claim 35 also corrects applicant's failure to claim in the '947 patent a control apparatus which included as elements "a tuner," "a memory," "an operator-actuated control device," and "a processor," specifically in a claim which included the elements recited in claim 35. This error arose through applicant and his attorney failing to appreciate that it was not necessary to include the tuner means of the television receiver as an element in claims to the control apparatus which applicant had invented, and that the recited claim elements could have been presented in a form other than as a "means" for performing a function. Applicant and his attorney failed to appreciate that a claim in accord with claim 35 was within the scope of the invention, and that it should have been presented in the application for the '947 patent.

This error is properly correctable through reissue. "An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents." *In re Wilder*, 222 USPQ 369, 371 (CAFC 1984). Such error supports a broadening reissue application. "[A]

broadened reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention." *In re Amos*, 21 USPQ2d 1271, 1273 (CAFC 1991).

Moreover, whether the errors could have been avoided is immaterial. As stated by the CAFC in *Scripps Clinic*, 18 USPQ2d at 1009, "[t]he law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue."

One particular error which is corrected by claim 35 pertains to the inclusion in all of the claims of the '947 patent of claim elements expressed in terms of "means for" language. By not including some claims which did not use the expression "means for," applicant erroneously failed to claim the invention sufficiently broadly. (See further discussion, *infra*.)

As explained in the attorney's declaration, *Sub. Boshinski Decl. at 193*, this error was discovered during 1994 as a result of the CAFC decision in *In re Donaldson*, 29 USPQ2d 1845 (1994). In its decision, the CAFC required that the PTO apply the "equivalents" analysis mandated by 35 USC 112, sixth paragraph, to its consideration of claims for patentability under sections 102 and 103. As a result of that decision, and subsequent discussions with applicant's trial counsel and other professional colleagues, applicant's attorney realized that the claims of the '947 patent should have included claims in which the elements were not expressed as "means" for performing various functions.

The fact that this error could perhaps be characterized as "legal" error, rather than factual error, does not preclude this error from being correctable by reissue. As noted by the CAFC in *Scripps Clinic v. Genentech Inc.*, *supra*, 18 USPQ2d at 1009, "[a]n error of law is not excluded from the class of error subject to correction in accordance with the reissue statute." Thus, this particular is a proper error for correction by reissue.

The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 322-335*.



*Claim 36*

Claim 36 corrects applicant's failure to claim in the '947 patent a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element. Claim 36 also corrects applicant's failure to claim in the '947 patent a control apparatus which included as elements "a tuner," "a memory," "an operator-actuated control device," and "a processor," specifically in a claim which included the elements recited in claim 36. This error arose through applicant and his attorney failing to appreciate that it was not necessary to include the tuner means of the television receiver as an element in claims to the control apparatus which applicant had invented, and that the recited claim elements could have been presented in a form other than as a "means" for performing a function. Applicant and his attorney failed to appreciate that a claim in accord with claim 36 was within the scope of the invention, and that it should have been presented in the application for the '947 patent.

This error is properly correctable through reissue. "An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents." *In re Wilder*, 222 USPQ 369, 371 (CAFC 1984). Such error supports a broadening reissue application. "[A] broadened reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention." *In re Amos*, 21 USPQ2d 1271, 1273 (CAFC 1991).

Moreover, whether the errors could have been avoided is immaterial. As stated by the CAFC in *Scripps Clinic*, 18 USPQ2d at 1009, "[t]he law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue."

One particular error which is corrected by claim 36 pertains to the inclusion in all of the claims of the '947 patent of claim elements expressed in terms of "means for" language. By not including some claims which did not use the expression "means for," applicant erroneously failed to claim the invention sufficiently broadly. (See further discussion, *infra*.)

As explained in the attorney's declaration, *Sub. Boshinski Decl. at 201*, this error was discovered during 1994 as a result of the CAFC decision in *In re Donaldson*, 29 USPQ2d 1845 (1994). In its decision, the CAFC required that the PTO apply the "equivalents" analysis mandated by 35 USC 112, sixth paragraph, to its consideration of claims for patentability under sections 102 and 103. As a result of that decision, and subsequent discussions with applicant's trial counsel and other professional colleagues, applicant's attorney realized that the claims of the '947 patent should have included claims in which the elements were not expressed as "means" for performing various functions.

The fact that this error could perhaps be characterized as "legal" error, rather than factual error, does not preclude this error from being correctable by reissue. As noted by the CAFC in *Scripps Clinic v. Genentech Inc.*, *supra*, 18 USPQ2d at 1009, "[a]n error of law is not excluded from the class of error subject to correction in accordance with the reissue statute." Thus, this particular is a proper error for correction by reissue.

The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 336-349*.

#### *Claim 37*

Claim 37 corrects applicant's failure to claim in the '947 patent a control apparatus for a television receiver in which the apparatus could store channel designations in an ordered cue. Claim 37 also corrects applicant's failure to claim in the '947 patent a control apparatus which included as elements "a tuner," "a memory," "an operator-actuated control device," and "a processor," specifically in a claim which included the elements recited in claim 37. This error arose through applicant and his attorney failing the appreciate that the invention included within its scope an apparatus which could store channel designations in an ordered cue, without incorporation into a remote control device in combination with the operator-selected channel designation feature, and that the recited claim elements could have been presented in a form other than as a "means" for performing a function. Applicant and his attorney failed to

appreciate that a claim in accord with claim 37 was within the scope of the invention, and that it should have been presented in the application for the '947 patent.

This error is properly correctable through reissue. "An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents." *In re Wilder*, 222 USPQ 369, 371 (CAFC 1984). Such error supports a broadening reissue application. "[A] broadened reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention." *In re Amos*, 21 USPQ2d 1271, 1273 (CAFC 1991).

Moreover, whether the errors could have been avoided is immaterial. As stated by the CAFC in *Scripps Clinic*, 18 USPQ2d at 1009, "[t]he law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue."

One particular error which is corrected by claim 37 pertains to the inclusion in all of the claims of the '947 patent of claim elements expressed in terms of "means for" language. By not including some claims which did not use the expression "means for," applicant erroneously failed to claim the invention sufficiently broadly. (See further discussion, *infra*.)

As explained in the attorney's declaration, *Sub. Boshinski Decl. at 209*, this error was discovered during 1994 as a result of the CAFC decision in *In re Donaldson*, 29 USPQ2d 1845 (1994). In its decision, the CAFC required that the PTO apply the "equivalents" analysis mandated by 35 USC 112, sixth paragraph, to its consideration of claims for patentability under sections 102 and 103. As a result of that decision, and subsequent discussions with applicant's trial counsel and other professional colleagues, applicant's attorney realized that the claims of the '947 patent should have included claims in which the elements were not expressed as "means" for performing various functions.

The fact that this error could perhaps be characterized as "legal" error, rather than factual error, does not preclude this error from being correctable by reissue. As noted by the CAFC in

*Scripps Clinic v. Genentech Inc.*, *supra*, 18 USPQ2d at 1009, "[a]n error of law is not excluded from the class of error subject to correction in accordance with the reissue statute." Thus, this particular is a proper error for correction by reissue.

The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 350-363*.

### *Claim 38*

Claim 38 corrects applicant's failure to claim in the '947 patent a control apparatus for a television receiver in which a memory clear signal can be used to restore, for one of the channel tuning designations, a channel select designation which is identical thereto, in an apparatus that did not include a tuner means for the television receiver as one of its elements, specifically in a claim which included the elements recited in claim 39. This error arose through applicant and his attorney failing to appreciate that the invention included within its scope an apparatus which could perform this operation. Applicant and his attorney failed to appreciate that a claim in accord with claim 38 was within the scope of the invention, and that it should have been presented in the application for the '947 patent.

This error is properly correctable through reissue. "An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents." *In re Wilder*, 222 USPQ 369, 371 (CAFC 1984). Such error supports a broadening reissue application. "[A] broadened reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention." *In re Amos*, 21 USPQ2d 1271, 1273 (CAFC 1991).

Moreover, whether the errors could have been avoided is immaterial. As stated by the CAFC in *Scripps Clinic*, 18 USPQ2d at 1009, "[t]he law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue."

The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 364-375.*

*Claim 39*

Claim 38 corrects applicant's failure to claim in the '947 patent a control apparatus for a television receiver in which a memory clear signal can be used to restore, for one of the channel tuning designations, a channel select designation which is identical thereto, specifically in a claim which included the elements recited in claim 38. This error arose through applicant and his attorney failing to appreciate that the invention included within its scope an apparatus which could perform this operation, and through failing to appreciate that it was not necessary to include the tuner means of the television receiver as an element in claims to the control apparatus which applicant had invented. Applicant and his attorney failed to appreciate that a claim in accord with claim 39 was within the scope of the invention, and that it should have been presented in the application for the '947 patent.

This error is properly correctable through reissue. "An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents." *In re Wilder*, 222 USPQ 369, 371 (CAFC 1984). Such error supports a broadening reissue application. "[A] broadened reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention." *In re Amos*, 21 USPQ2d 1271, 1273 (CAFC 1991).

Moreover, whether the errors could have been avoided is immaterial. As stated by the CAFC in *Scripps Clinic*, 18 USPQ2d at 1009, "[t]he law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue."

The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 376-389.*

*Claim 40*

Claim 40 corrects applicant's failure to claim in the '947 patent a control apparatus for a television receiver in which the apparatus could store channel designations in a plurality of ordered scroll sequences, and specifically in a claim which included the elements recited in claim 40. This error arose through applicant and his attorney failing to appreciate that the invention included within its scope an apparatus which could store channel designations in an ordered scroll sequences, without incorporation into a remote control device in combination with the operator-selected channel designation feature. Applicant and his attorney failed to appreciate that a claim in accord with claim 40 was within the scope of the invention, and that it should have been presented in the application for the '947 patent.

This error is properly correctable through reissue. "An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents." *In re Wilder*, 222 USPQ 369, 371 (CAFC 1984). Such error supports a broadening reissue application. "[A] broadened reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention." *In re Amos*, 21 USPQ2d 1271, 1273 (CAFC 1991).

Moreover, whether the errors could have been avoided is immaterial. As stated by the CAFC in *Scripps Clinic*, 18 USPQ2d at 1009, "[t]he law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue."

The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 390-402*.

*Claim 41*

Claim 41 corrects applicant's failure to claim in the '947 patent a control apparatus for a television receiver in which the apparatus could store channel designations in a plurality of ordered scroll sequences, and which includes means for generating a scroll sequence selection signal, specifically in a claim which included the elements recited in claim 41. This error arose

through applicant and his attorney failing the appreciate that the invention included within its scope an apparatus which could store channel designations in an ordered scroll sequences, and which includes means for generating a scroll sequence selection signal, without incorporation into a remote control device in combination with the operator-selected channel designation feature. Applicant and his attorney failed to appreciate that a claim in accord with claim 41 was within the scope of the invention, and that it should have been presented in the application for the '947 patent.

This error is properly correctable through reissue. "An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents." *In re Wilder*, 222 USPQ 369, 371 (CAFC 1984). Such error supports a broadening reissue application. "[A] broadened reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention." *In re Amos*, 21 USPQ2d 1271, 1273 (CAFC 1991).

Moreover, whether the errors could have been avoided is immaterial. As stated by the CAFC in *Scripps Clinic*, 18 USPQ2d at 1009, "[t]he law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue."

The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 403-414*.

#### *Claim 42*

Claim 42 corrects applicant's failure to claim in the '947 patent a control apparatus for a television receiver in which the apparatus could store channel designations in a plurality of ordered scroll sequences, and specifically in a claim which included the elements recited in claim 42. This error arose through applicant and his attorney failing the appreciate that the invention included within its scope an apparatus which could store channel designations in an ordered scroll sequences, without incorporation into a remote control device in combination with the operator-selected channel designation feature. Applicant and his attorney failed to appreciate that

a claim in accord with claim 42 was within the scope of the invention, and that it should have been presented in the application for the '947 patent.

This error is properly correctable through reissue. "An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents." *In re Wilder*, 222 USPQ 369, 371 (CAFC 1984). Such error supports a broadening reissue application. "[A] broadened reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention." *In re Amos*, 21 USPQ2d 1271, 1273 (CAFC 1991).

Moreover, whether the errors could have been avoided is immaterial. As stated by the CAFC in *Scripps Clinic*, 18 USPQ2d at 1009, "[t]he law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue."

The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 415-426*.

#### *Claim 43*

Claim 43 corrects applicant's failure to claim in the '947 patent a control apparatus for a television receiver in which the apparatus could store channel designations in a plurality of ordered scroll sequences, and specifically in a claim which included the elements recited in claim 43. This error arose through applicant and his attorney failing the appreciate that the invention included within its scope an apparatus which could store channel designations in an ordered scroll sequences, without incorporation into a remote control device in combination with the operator-selected channel designation feature. Applicant and his attorney failed to appreciate that a claim in accord with claim 43 was within the scope of the invention, and that it should have been presented in the application for the '947 patent.

This error is properly correctable through reissue. "An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents." *In re Wilder*,



222 USPQ 369, 371 (CAFC 1984). Such error supports a broadening reissue application. "[A] broadened reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention." *In re Amos*, 21 USPQ2d 1271, 1273 (CAFC 1991).

Moreover, whether the errors could have been avoided is immaterial. As stated by the CAFC in *Scripps Clinic*, 18 USPQ2d at 1009, "[t]he law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue."

The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 427-441*.

#### *Claim 44*

Claim 44 corrects applicant's failure to claim in the '947 patent a control apparatus for a television receiver in which the apparatus could store channel designations in a plurality of ordered scroll sequences, and specifically in a claim which included the elements recited in claim 44. This error arose through applicant and his attorney failing to appreciate that the invention included within its scope an apparatus which could store channel designations in an ordered scroll sequences, without incorporation into a remote control device in combination with the operator-selected channel designation feature. Applicant and his attorney failed to appreciate that a claim in accord with claim 44 was within the scope of the invention, and that it should have been presented in the application for the '947 patent.

This error is properly correctable through reissue. "An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents." *In re Wilder*, 222 USPQ 369, 371 (CAFC 1984). Such error supports a broadening reissue application. "[A] broadened reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention." *In re Amos*, 21 USPQ2d 1271, 1273 (CAFC 1991).

Moreover, whether the errors could have been avoided is immaterial. As stated by the CAFC in *Scripps Clinic*, 18 USPQ2d at 1009, "[t]he law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue."

The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 442-454.*

#### *Claim 45*

Claim 45 corrects applicant's failure to claim in the '947 patent a control apparatus for a television receiver in which the apparatus could store channel designations in an ordered cue as determined by the operator, in which the processor performed operations "following receipt of" the presence of a particular signal, and specifically in a claim which included the elements recited in claim 45. This error arose through applicant and his attorney failing to appreciate that the invention included within its scope an apparatus in which the processor performed operations "following receipt of" the presence of a particular signal. Applicant and his attorney failed to appreciate that a claim in accord with claim 45 was within the scope of the invention, and that it should have been presented in the application for the '947 patent.

This error is properly correctable through reissue. "An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents." *In re Wilder*, 222 USPQ 369, 371 (CAFC 1984). Such error supports a broadening reissue application. "[A] broadened reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention." *In re Amos*, 21 USPQ2d 1271, 1273 (CAFC 1991).

Moreover, whether the errors could have been avoided is immaterial. As stated by the CAFC in *Scripps Clinic*, 18 USPQ2d at 1009, "[t]he law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue."

The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 455-467.*

*Claim 46*

Claim 46 corrects applicant's failure to claim in the '947 patent a control apparatus for a television receiver in which the apparatus could store channel designations in an ordered cue as determined by the operator, in which the processor performed operations "following receipt of" the presence of a particular signal, and specifically in a claim which included the elements recited in claim 46. This error arose through applicant and his attorney failing to appreciate that the invention included within its scope an apparatus in which the processor performed operations "following receipt of" the presence of a particular signal. Applicant and his attorney failed to appreciate that a claim in accord with claim 46 was within the scope of the invention, and that it should have been presented in the application for the '947 patent.

This error is properly correctable through reissue. "An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents." *In re Wilder*, 222 USPQ 369, 371 (CAFC 1984). Such error supports a broadening reissue application. "[A] broadened reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention." *In re Amos*, 21 USPQ2d 1271, 1273 (CAFC 1991).

Moreover, whether the errors could have been avoided is immaterial. As stated by the CAFC in *Scripps Clinic*, 18 USPQ2d at 1009, "[t]he law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue."

The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 468-480.*

*Claim 47*

Claim 47 corrects applicant's failure to claim in the '947 patent a control apparatus for a television receiver in which the apparatus could store channel designations in an ordered cue as determined by the operator, in which the processor performed operations "following receipt of" the presence of a particular signal, and specifically in a claim which included the elements recited in claim 47. This error arose through applicant and his attorney failing to appreciate that the invention included within its scope an apparatus in which the processor performed operations "following receipt of" the presence of a particular signal. Applicant and his attorney failed to appreciate that a claim in accord with claim 47 was within the scope of the invention, and that it should have been presented in the application for the '947 patent.

This error is properly correctable through reissue. "An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents." *In re Wilder*, 222 USPQ 369, 371 (CAFC 1984). Such error supports a broadening reissue application. "[A] broadened reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention." *In re Amos*, 21 USPQ2d 1271, 1273 (CAFC 1991).

Moreover, whether the errors could have been avoided is immaterial. As stated by the CAFC in *Scripps Clinic*, 18 USPQ2d at 1009, "[t]he law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue."

The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 481-493*.

*Claim 48*

Claim 48 corrects applicant's failure to claim in the '947 patent a control apparatus for a television receiver in which a television screen was one of the claim elements, and specifically in a claim which included the elements recited in claim 48. This error arose through applicant and his attorney failing to appreciate that the invention included within its scope an apparatus

in which the television screen was one of the claim elements. Applicant and his attorney failed to appreciate that a claim in accord with claim 48 was within the scope of the invention, and that it should have been presented in the application for the '947 patent.

This error is properly correctable through reissue. "An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents." *In re Wilder*, 222 USPQ 369, 371 (CAFC 1984). Such error supports a broadening reissue application. "[A] broadened reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention." *In re Amos*, 21 USPQ2d 1271, 1273 (CAFC 1991).

Moreover, whether the errors could have been avoided is immaterial. As stated by the CAFC in *Scripps Clinic*, 18 USPQ2d at 1009, "[t]he law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue."

The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 494-505*.

#### *Claim 49*

Claim 49 corrects applicant's failure to claim in the '947 patent a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element, in which the processor performed operations "in response to" the presence of a particular signal, in which the apparatus stored "select codes" which corresponded to "channel codes," and specifically in a claim which included the elements recited in claim 49. This error arose through applicant and his attorney failing to appreciate that it was not necessary to include the tuner means of the television receiver as an element in claims to the control apparatus which applicant had invented, and that a claim in accord with claim 49 was within the scope of the invention, and that it should have been presented in the application for the '947 patent.

This error is properly correctable through reissue. "An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents." *In re Wilder*, 222 USPQ 369, 371 (CAFC 1984). Such error supports a broadening reissue application. "[A] broadened reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention." *In re Amos*, 21 USPQ2d 1271, 1273 (CAFC 1991).

Moreover, whether the errors could have been avoided is immaterial. As stated by the CAFC in *Scripps Clinic*, 18 USPQ2d at 1009, "[t]he law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue."

The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 506-520*.

#### *Claim 50*

Claim 50 corrects applicant's failure to claim in the '947 patent a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element, in which the processor performed operations "in response to" the presence of a particular signal, in which the apparatus stored "select codes" which corresponded to "channel codes," and specifically in a claim which included the elements recited in claim 50. This error arose through applicant and his attorney failing to appreciate that it was not necessary to include the tuner means of the television receiver as an element in claims to the control apparatus which applicant had invented, and that a claim in accord with claim 50 was within the scope of the invention, and that it should have been presented in the application for the '947 patent.

This error is properly correctable through reissue. "An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents." *In re Wilder*, 222 USPQ 369, 371 (CAFC 1984). Such error supports a broadening reissue application. "[A] broadened reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention." *In re Amos*, 21 USPQ2d 1271, 1273 (CAFC 1991).

Moreover, whether the errors could have been avoided is immaterial. As stated by the CAFC in *Scripps Clinic*, 18 USPQ2d at 1009, "[t]he law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue."

The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 521-535*.

#### *Claim 51*

Claim 51 corrects applicant's failure to claim in the '947 patent a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element, in which the processor performed operations "in response to" the presence of a particular signal, in which the apparatus stored "select codes" which corresponded to "channel codes," and specifically in a claim which included the elements recited in claim 51. This error arose through applicant and his attorney failing to appreciate that it was not necessary to include the tuner means of the television receiver as an element in claims to the control apparatus which applicant had invented, and that a claim in accord with claim 51 was within the scope of the invention, and that it should have been presented in the application for the '947 patent.

This error is properly correctable through reissue. "An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents." *In re Wilder*, 222 USPQ 369, 371 (CAFC 1984). Such error supports a broadening reissue application. "[A] broadened reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention." *In re Amos*, 21 USPQ2d 1271, 1273 (CAFC 1991).

Moreover, whether the errors could have been avoided is immaterial. As stated by the CAFC in *Scripps Clinic*, 18 USPQ2d at 1009, "[t]he law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue."

The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 536-550.*

*Claim 52*

Claim 52 corrects applicant's failure to claim in the '947 patent a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element, in which the processor performed operations "in response to" the presence of a particular signal, in which the apparatus stored "select codes" which corresponded to "channel codes," and specifically in a claim which included the elements recited in claim 52. This error arose through applicant and his attorney failing to appreciate that it was not necessary to include the tuner means of the television receiver as an element in claims to the control apparatus which applicant had invented, and that a claim in accord with claim 52 was within the scope of the invention, and that it should have been presented in the application for the '947 patent.

This error is properly correctable through reissue. "An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents." *In re Wilder*, 222 USPQ 369, 371 (CAFC 1984). Such error supports a broadening reissue application. "[A] broadened reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention." *In re Amos*, 21 USPQ2d 1271, 1273 (CAFC 1991).

Moreover, whether the errors could have been avoided is immaterial. As stated by the CAFC in *Scripps Clinic*, 18 USPQ2d at 1009, "[t]he law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue."

The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 551-565.*



*Claim 53*

Claim 53 corrects applicant's failure to claim in the '947 patent a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element, in which the processor performed operations "in response to" the presence of a particular signal, in which the apparatus stored "select codes" which corresponded to "channel codes," and specifically in a claim which included the elements recited in claim 53. This error arose through applicant and his attorney failing to appreciate that it was not necessary to include the tuner means of the television receiver as an element in claims to the control apparatus which applicant had invented, and that a claim in accord with claim 53 was within the scope of the invention, and that it should have been presented in the application for the '947 patent.

This error is properly correctable through reissue. "An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents." *In re Wilder*, 222 USPQ 369, 371 (CAFC 1984). Such error supports a broadening reissue application. "[A] broadened reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention." *In re Amos*, 21 USPQ2d 1271, 1273 (CAFC 1991).

Moreover, whether the errors could have been avoided is immaterial. As stated by the CAFC in *Scripps Clinic*, 18 USPQ2d at 1009, "[t]he law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue."

The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 566-580*.

*Claim 54*

Claim 54 corrects applicant's failure to claim in the '947 patent a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element, in which the processor performed operations "in response to" the presence of a particular signal, wherein the "channel tuning designation" is defined as being "in a first series," the "channel

select designation" is defined as being "in a second series," and the "channel display designation" is defined as being "in third series." Claim 54 further corrects applicant's failure to claim in the '947 patent a control apparatus in which the apparatus stored "select codes" which corresponded to "channel codes," and specifically in a claim which included the elements recited in claim 54. This error arose through applicant and his attorney failing to appreciate that it was not necessary to include the tuner means of the television receiver as an element in claims to the control apparatus which applicant had invented, and that a claim in accord with claim 54 was within the scope of the invention, and that it should have been presented in the application for the '947 patent.

This error is properly correctable through reissue. "An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents." *In re Wilder*, 222 USPQ 369, 371 (CAFC 1984). Such error supports a broadening reissue application. "[A] broadened reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention." *In re Amos*, 21 USPQ2d 1271, 1273 (CAFC 1991).

Moreover, whether the errors could have been avoided is immaterial. As stated by the CAFC in *Scripps Clinic*, 18 USPQ2d at 1009, "[t]he law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue."

The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 581-595*.

#### *Claim 55*

Claim 55 corrects applicant's failure to claim in the '947 patent a method of controlling a television receiver in which certain steps of the method are performed by a "first" and a "second" person, and specifically in a claim which included the elements recited in claim 55. This error arose through applicant and his attorney failing to appreciate that the invention included within its scope a method in which certain steps of the method are performed by a

"first" and a "second" person. Applicant and his attorney failed to appreciate that a claim in accord with claim 55 was within the scope of the invention, and that it should have been presented in the application for the '947 patent.

This error is properly correctable through reissue. "An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents." *In re Wilder*, 222 USPQ 369, 371 (CAFC 1984). Such error supports a broadening reissue application. "[A] broadened reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention." *In re Amos*, 21 USPQ2d 1271, 1273 (CAFC 1991).

Moreover, whether the errors could have been avoided is immaterial. As stated by the CAFC in *Scripps Clinic*, 18 USPQ2d at 1009, "[t]he law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue."

The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 596-606*.

#### *Claim 56*

Claim 56 corrects applicant's failure to claim in the '947 patent a method of controlling a television receiver in which certain steps of the method are performed by a "first" and a "second" person, and specifically in a claim which included the elements recited in claim 56. This error arose through applicant and his attorney failing to appreciate that the invention included within its scope a method in which certain steps of the method are performed by a "first" and a "second" person. Applicant and his attorney failed to appreciate that a claim in accord with claim 56 was within the scope of the invention, and that it should have been presented in the application for the '947 patent.

This error is properly correctable through reissue. "An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents." *In re Wilder*,

222 USPQ 369, 371 (CAFC 1984). Such error supports a broadening reissue application. "[A] broadened reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention." *In re Amos*, 21 USPQ2d 1271, 1273 (CAFC 1991).

Moreover, whether the errors could have been avoided is immaterial. As stated by the CAFC in *Scripps Clinic*, 18 USPQ2d at 1009, "[t]he law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue."

The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 607-617*.

Errors in the Specification

*Column 4, lines 25-26*

It is clear from the remainder of the sentence in which this error appears that the word "convention" should read --conventional--. The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 619-622*.

*Column 9, line 14*

It is clear from the remainder of the sentence in which this error appears that what is being discussed is the "select code" and not the "channel code" as erroneously set forth. The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 623-626*.

*Column 9, line 53*

It is clear from the remainder of the sentence in which this error appears that the word "the" (first occurrence) should read --then--. The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 627-630*.

*Column 10, line 58*

With regard to the error appearing at column 10, line 58, the examiner is referred to lines 60-62 where it is clear that the reference is to the selection of channels (i.e., "select codes"). The reference to "display codes" is clearly in error. The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 631-634.*

*Column 11, lines 38-39*

With regard to the error appearing at column 11, lines 38-39, it is clear from line 37 that the reference should be to "select code" and not to "display code." The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 635-638.*

*Column 11, lines 39-40*

With regard to the error appearing at column 11, lines 39-40, it is clear from line 37 that the reference should be to "select code" and not to "display code." The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 639-642.*

*Column 12, line 19*

For column 12, line 19, the examiner is referred back to line 15 and the reference to "select code." It is clear that the "select code" is also being discussed in line 19, and the reference to "display code" is in error. The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 643-646.*

*Column 12, line 21*

It is clear from reference to Fig. 7 that "208" should read --210--. The Third Substitute Declaration details how and when the error occurred, and how, when and by whom the error was discovered. *TSD at 647-650.*